

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STAN SCHALL, JR.

Appeal No. 2005-1649
Application No. 09/310,965

ON BRIEF

Before FRANKFORT, McQUADE and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Stan Schall, Jr. originally took this appeal from the final rejection of claims 1-3, 6-9, 15, 16, 21 and 22. The appellant has since withdrawn claim 15 from the appeal, and the examiner has since withdrawn the rejections of claims 1, 3, 16, 21 and 22. Hence, the appeal now involves only claims 2 and 6-9. Claim 15 stands finally rejected and not appealed, claims 1, 3, 10, 13, 14, 16, 21 and 22 stand allowed, claim 4, which has been indicated as reciting allowable subject matter, presumably stands objected to as

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depending from a rejected base claim, and claims 5, 11, 12 and 17-20, the only other claims pending in the application, stand withdrawn from consideration.

THE INVENTION

The subject matter on appeal relates to an exercise device.
Representative claim 6 reads as follows:

6. An exercise device comprising:

a upper platform,

a lower housing connected to said upper platform, said lower housing includes a floor with a hole passing therethrough,

a lower housing cap resting on and aligned with said lower housing,

a bearing element resting on said lower housing cap and abutting said upper platform, said bearing element allows said upper platform to rotate relative to said lower housing, and

regulating components that control rotation between said lower housing and said upper platform, said regulating components include an adjustment mechanism; and

wherein said adjustment mechanism is accessible through the hole in said floor of said lower housing.

THE PRIOR ART

The references relied on by the examiner to support the prior art rejections remaining on appeal are:

Hovda	1,533,500	Apr. 14, 1925
Titus	2,256,001	Sep. 16, 1941

THE REJECTIONS

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 6, 7 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hovda and, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Hovda.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hovda in view of Titus.

Attention is directed to the main and reply briefs (filed January 22, 2004 and June 21, 2004) and the final rejection and answer (mailed November 14, 2002 and April 20, 2004) for the respective positions of the appellant and examiner regarding the merits of these rejections.¹

DISCUSSION

I. The 35 U.S.C. § 112, second paragraph, rejection of claim 2

Claim 2 recites an exercise device having a handle with a gripping area that includes "a bottom angled at fourteen degrees

¹ Although the examiner failed to restate the 35 U.S.C. § 112, second paragraph, rejection in the answer, the remarks in the response to argument section of the answer indicate that the omission was inadvertent.

with the horizontal plane." The examiner submits that this recitation renders the claim indefinite because "'with the horizontal plane' is not clear as how and by what structural element being used to define the horizontal plane, and whether or not the 'plane' is part of the invention" (final rejection, page 2).

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

Page 8 in the appellant's specification describes the constituent parts of the exercise device handle within the context of the normal upright orientation of the device as shown in Figures 1(a)-1(c). This description includes language similar to that at issue in claim 2. A person of ordinary skill in the art, reading the claim in light of this disclosure, would readily understand the recitation in question as meaning that the bottom of the handle

gripping area is disposed at an angle of fourteen degrees relative to horizontal when the exercise device is in its normal upright or vertical orientation. Thus, the examiner's position that claim 2 is indefinite is not well founded.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claim 2.

II. The 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) rejections of claims 6, 7 and 9 based on Hovda

Hovda discloses a device for demonstrating, presumably in a teaching or classroom environment, the principle of conservation of angular momentum. The following passage from the reference fairly describes the construction of the device and the manner in which it is used:

In carrying out my invention I provide two discs 1 and 2 respectively. . . . As will be seen from Figure 1, the lower disc 2 is provided with a central bore 3 extending from one side to a recess 4 on the other side. The disc 1 has a recess 5 similar to the recess 4. A ring 6 is provided in the recess 4, while a plate 7 is disposed in the recess 5 of the disc 1.

Between the discs is a bearing plate 8 of metal, which has a circular groove 9. The bearing plate 8 is secured to the disc 1 by means of bolts 10, which are countersunk, and which pass through the bearing plate 8, the disc 1, and the plate 7, and are secured by nuts 11.

Similarly the plate 2 is provided with a bearing plate 12 having a circular groove 13 registering with the groove 9. This bearing plate is secured to the disc 2 by means of bolts 14, which are countersunk, and which are provided with nuts 15 that are designed to bear against the ring 6.

Disposed within the central recess 3 is a bearing plate 16 having a circular groove 17 arranged to register with the circular groove 18 in the bearing plate 12. A screw bolt 19 is provided with a head 20 which bears on the plate 7, and which passes through the plate, the disc 1, the bearing plates 8 and 12, and is threaded to the plate 16. Nuts 21 are provided for locking the plate 16 in its adjusted position. Antifriction balls 22 are disposed between the bearing plates 8 and 12, and 16 and 12. Dust plates 23 are provided for covering the recesses 4 and 5, these dust plates being countersunk so as to present a smooth surface on the exterior face of either of the discs 1 and 2. The construction just described is one example of the way in which the rotatable device may be made. It will be observed that this provides two strong discs, either of which may serve as a base, and the other as the support of the demonstrator. The discs are mounted to rotate freely, but the bearings are so distributed that the thrust is over a relatively wide area, the consequence being that even if the weight on the disc is not evenly distributed, the device will operate.

In demonstrating the conservation of angular momentum, the demonstrator places the device upon the floor and stands upon the disc with his arms outstretched, and preferably holds a weight (a pound or so) in each hand. His assistant sets him in slow rotation, and while the disc is turning, he lowers his hands quickly. This causes the speeding-up of rotation, which is slowed up when his arms are raised into the first position. The change in speed can readily be seen by any observer while of course the change in the tendency to produce rotation can easily be felt by the one who is standing on the disc [page 1, line 44, through page 2, line 3].

As framed and argued by the appellant, the dispositive issues with respect to the § 102(b) and § 103(a) rejections of claim 6 are whether Hovda teaches or would have suggested a device responsive to the limitations in the claim relating to the regulating components. The appellant does not dispute the examiner's finding that Hovda's upper disc 1 and lower disc 2 respectively constitute an upper platform and a lower housing having a floor with a hole passing therethrough as recited in the claim. The appellant does challenge, however, the examiner's determination that Hovda's bolt 19, bolt head 20 and nuts 21 constitute regulating components that control rotation between the lower housing and upper platform, with the nuts 21 embodying an adjustment mechanism which is accessible through the hole in the lower housing. According to the appellant, (1) Hovda does not contain any disclosure that these elements are rotation regulating components and (2) nuts 21 are not physically capable of functioning as an adjustment mechanism due to the threaded connection between bolt 19 and bearing plate 16.

The latter argument is convincing. As disclosed by Hovda, "[n]uts 21 are provided for locking the plate 16 in its adjusted position" (page 1, lines 81-83). In other words, the nuts 21 are simply lock nuts that hold the plate 16 in a desired position on the bolt 19 by preventing relative rotation between the two.

Rotation of the nuts, in and of itself, will not result in any regulation or control of the rotation between the lower housing (lower disc 2) and upper platform (upper disc 1). Thus, as applied by the examiner, Hovda does not teach, and would not have suggested, regulating components as set forth in claim 6.

Nonetheless, Hovda's bolt 19, bolt head 20, nuts 21 and plate 16 do compose such regulating components with the nuts 21 and plate 16 collectively defining an adjustment mechanism as recited in claim 6. In this regard, it is not apparent why the nuts 21 and plate 16, which are accessible through the hole in the lower disc, are not inherently capable of being adjusted to regulate or control the relative rotation of the discs. Ostensibly, tightening the plate 16 on the bolt 19 would increase resistance to such rotation and loosening the plate would decrease the resistance. Given this evident inherent capability, it is of no moment that Hovda does not teach that these elements can be used in this manner. It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. In re Swinehart, 439 F.2d 210, 214 , 169 USPQ 226, 229 (CCPA 1971).

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Thus, notwithstanding the appellant's arguments to the contrary, Hovda does disclose a device responsive to the limitations in claim 6 pertaining to the regulating components. We shall therefore sustain the standing 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) rejections of claim 6 based on Hovda.

We also shall sustain the standing 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) rejections of claim 9, which depends from claim 6, based on Hovda since the appellant has not challenged such with any reasonable specificity, thereby allowing claim 9 to stand or fall with claim 6 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

We shall not sustain the standing 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) rejections of claim 7 based on Hovda.

Claim 7 depends from claim 6 and further defines the regulating components as including a friction material that is variably set to provide a range of resistance levels. In short, Hovda neither teaches nor would have suggested any such variably settable friction material.

III. The 35 U.S.C. § 103(a) rejection of claim 8 as being unpatentable over Hovda in view of Titus

Claim 8 depends from claim 6 and recites a footing attached to the lower housing opposite the lower housing cap. Acknowledging that the Hovda device has no such footing, the examiner turns to Titus.

Titus discloses an exerciser having relatively rotatable upper and lower plates or discs 12 and 10. The lower plate 10 includes rubber feet 11 on its bottom surface to prevent the exerciser from slipping on the floor or support on which it is disposed.

Combining Hovda and Titus to reject claim 8, the examiner submits that it would have been obvious "to provide Hovda's device with [a] footing as taught by Titus, in order to prevent the device from slipping on the floor or support" (final rejection, pages 6 and 7).

This proposed reference combination is reasonable on its face. The disclosure by Titus of the slip prevention advantage afforded by the rubber feet 11 would have furnished the artisan with ample suggestion or motivation to provide a similar footing on the Hovda device for the same reason. The appellant's contention that Hovda teaches away from such a modification because the addition of a footing would prevent the device from being used in

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an inverted position as intended by Hovda is unpersuasive. The appellant has not cogently explained, and it is not apparent, why the addition of the footing would prevent such use of the Hovda device.

SUMMARY

The decision of the examiner:

a) to reject claim 2 under 35 U.S.C. § 112, second paragraph, is reversed;

b) to reject claims 6, 7 and 9 under 35 U.S.C. § 102(b) as being anticipated by Hovda and, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Hovda is affirmed with respect to claims 6 and 9 and reversed with respect to claim 7; and

c) to reject claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Hovda in view of Titus is affirmed.

Since our rationale for affirming the rejections of claims 6, 8 and 9 differs from that advanced by the examiner with regard to the manner in which Hovda meets the limitations in claim 6 relating to the regulating components, we hereby designate these affirmed rejections as new grounds of rejection under 37 CFR § 41.50(b) to allow the appellant a fair opportunity to react thereto.

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This decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .


(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .


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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 CFR § 41.50(b).

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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